

REMARKS

The present amendments and remarks are responsive to an Office Action mailed June 23, 2005, where the Examiner has rejected claims 1-18. Herein, applicant has amended claim 10. Reconsideration and allowance of pending claims 1-18 is respectfully requested in view of the following remarks.

A. Rejection of claims under 35 USC §103 in Section 1

In section 1 of the office action, the Examiner rejects claims 1-5 and 8-17 under 35 USC 103(a) as being unpatentable over Lee (US. Pat. No. 6,590,887) in view of Moskowitz (US Pat. No. 5,249,220).

1. Claim 1

The applicant respectfully traverses the rejection of claim 1, and submits that the Examiner has not made a *prima facie* case of obviousness as to claim 1 and its dependent claims 2-5 and 8-9.

The requirements for a *prima facie* case are generally set out at MPEP §2142:

*To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*

Not all claim limitations are taught or suggested. Claim 1 generally sets out four process steps of 1) evaluating, 2) selecting, 3) encoding, and 4) storing. Further, claim 1 defines a specific sequence in which these steps are to be performed. For example, the second limitation states that “selecting” is “in response to evaluating”, and the third limitation states that “encoding” is “in response to selecting”. Finally, the “storing” steps uses the “encoded SMS

message", so is performed after the "encoding" step. Accordingly, the method of claim 1 has a set of 4 general limitations that also define an ordered sequence.

This ordering of process steps is also illustrated in the detailed description of the application. For example, Fig. 1 shows that wireless device 101 has an optimizing circuit 102 which sends an optimizing signal 116 to the encoding circuit 104. Thus, the evaluation and selection process are performed in device 101 before the optimizing signal is passed to the encoding circuit. *See also, specification, pg. 9, Ins. 1-9.* This ordered process provides several advantages, including that:

more memory is made available in the wireless device 101 for other uses or it may be possible to reduce the amount of memory that I installed in the wireless device 101. (Specification, pg. 9, Ins. 22-25)."

The importance of the claimed order is also set out in the Summary of the Invention section on page 5:

10 • • • The optimizing subsystem evaluates the characters in the SMS message to identify which of the available encoding formats are usable for encoding the characters, determines a memory usage requirement, and selects, as the optimal encoding format, the usable encoding format having the lowest memory usage. The optimizing subsystem has an
15 output to supply an optimizing signal identifying the optimal encoding format.

 The encoding subsystem accepts the SMS message and the optimizing signal, and encodes the message in the optimal encoding format. • • •

This ordering is directed to solving the problem associates with the limited memory available on a wireless mobile device. As succinctly stated in the Summary of the Invention:

The invention addresses this by identifying the encoding formats available in the wireless device ... and selecting the encoding format with the smallest memory requirement as the optimal

encoding format. The SMS message is then encoded using the optimal encoding format and stored in wireless device memory. (Specification, pg. 4, ln. 24 to pg. 5, ln. 4)

In making the obviousness rejection, the Examiner first cites to Lee, finding that Lee discloses “encoding the SMS message in response to selecting the encoding format (the signal generated by the CDMA or PCS terminal is encoded: column 2, lines 31-52)”. However, the applicant submits that Lee fails to disclose any “selecting” process, and instead merely states the encoder/decoder 16 “encodes the signal generated by the CDMA or PCS terminal under the control of the controller 10 and outputs the encoded signal to the RF module 15.” The applicant believes that using a default encoder does not disclose or teach the “selecting” of an optimal encoding format from a set of available formats, as taught by the applicant’s specification.

The Examiner cannot find all the elements in Lee, so cites to Moskowitz to find “a method of evaluating resource encoding requirements for an SMS message and selecting an optimum encoding format for the SMS message in response to evaluating the resources”. For example, the Examiner cites, in part, to the following passage in Moskowitz (Moskowitz, col. 12, Ins. 3-6):

... The transmitter encodes the message that is to be sent to the receiver according to each format. ...

Thus, the transmitter FIRST encodes the message to EACH available encoding format, and then SECOND, after the encoding process is complete, determines which of the already encoded message formats uses the fewest number of bits. Accordingly, the applicant submits that the Examiner has not found any teaching showing an ordered process of: 1) evaluating a device resource, 2) selecting an optimal encoding format in response to evaluating, 3) encoding an SMS message using the selected optimal encoding format, and 4) storing the encoded SMS message .

Since Lee and Moskowitz, either alone or in combination, fail to disclose or teach all the limitations of claim 1, the applicant submits that Lee and Moskowitz can not render obvious claim 1 and its dependent claims 2-5 and 8-9.

There is no motivation to combine the Lee and Moskowitz. Not only do the cited references fail to disclose all the limitations of claim 1, there is also no motivation to combine Lee and Moskowitz, as Moskowitz teaches away from the device of Lee. For example, Lee has a memory 11 that includes a RAM (Random Access Memory) for temporarily storing data. *Lee, col. 2, Ins. 25-28.* As described in applicant's specification, memory in a wireless communication device is a limited and scarce resource, and if the SMS process uses increased memory, then the amount of memory available for other useful functions is undesirably reduced. *See, application, pg. 4, Ins. 9-14.* The process described in Moskowitz encodes an SMS message to EACH available encoding format, and stores each of those encoded messages in memory. *See, Moskowitz, col. 12, Ins. 3-40.* More particularly, the device of Moskowitz thereby may simultaneously store several encoded versions of the same SMS message, placing a burden on memory allocation, and limiting other useful applications. One skilled in the art would not find it attractive to implement a process so demanding on the limited memory resources available on a wireless device as disclosed in Lee.

Since Moskowitz teaches away from the device of Lee, the applicant respectfully submits there is no motivation to combine the cited references. Accordingly, Lee and Moskowitz can not render obvious claim 1 and its dependent claims 2-5 and 8-9.

2. Claim 10

The applicant has amended claim 10 to more clearly define the ordered steps for the claimed method. For example, although the third limitation referred to "usable formats" in the plural, the second limitation has been amended to expressly set out that there is "a plurality of encoding formats available". Also, it

has been made clear that the memory usage requirement is determined “without encoding the SMS message”, and that “selecting the encoding format” is “made responsive to determining the memory usage”. The sixth limitation already has the ordering limitation that encoding the SMS message is in response to selecting the optimal encoding format.

For similar reasons as set forth in Section A(1) above, the applicant respectfully submits that the Examiner will not be able to maintain a *prima facie* case of obviousness as to claim 10. Accordingly, Lee and Moskowitz can not render claim 10 obvious.

3. Claim 11

Claim 11 sets out a system having a structure for implementing an ordered process. For example, the optimizing and encoding subsystems are arranged such that the encoding subsystem supplies “the SMS message in a format responsive to the optimizing signal”.

This ordered structure is also illustrated in the detailed description of the application. For example, Fig. 1 shows that wireless device 101 has an optimizing circuit 102 which sends an optimizing signal 116 to the encoding circuit 104. Thus, the optimizing circuit generates an optimizing signal to be received by the encoding circuit. In this way, optimizing circuit 102 operates in device 101 so that the optimizing signal is passed to the encoding circuit, where the encoding circuit acts responsive to the optimizing signal. *See also, specification, pg. 9, Ins. 1-9.* This ordered structure provides several advantages, including that:

more memory is made available in the wireless device 101 for other uses or it may be possible to reduce the amount of memory that I installed in the wireless device 101. (Specification, pg. 9, Ins. 22-25). ”

For similar reasons as set forth in Section A(1) above, the applicant respectfully submits that the Examiner will not be able to maintain a *prima facie*

case of obviousness as to claim 11. Accordingly, Lee and Moskowitz can not render obvious claim 11 and its dependent claims 12-17.

B. Rejection of claims under 35 USC §103 in Section 2

In section 2 of the office action, the Examiner rejects claims 6 and 18 under 35 USC 103(a) as being unpatentable over Lee (US. Pat. No. 6,590,887) in view of Moskowitz (US Pat. No. 5,249,220), and further in view of Wolf (US Pat. No. 5,844,922).

The applicant respectfully submits that claim 6 is allowable based on its dependency from claim 5, which is now believed to be in form for allowance. Therefore, for reasons similar to those set out in Section A(1) above, the applicant respectfully submits that the Examiner will not be able to maintain a *prima facie* case of obviousness as to claim 6. Accordingly, Lee, Moskowitz, and Wolf can not render claim 6 obvious.

The applicant respectfully submits that claim 18 is allowable based on its dependency from claim 15, which is now believed to be in form for allowance. Therefore, for reasons similar to those set out in Section A(3) above, the applicant respectfully submits that the Examiner will not be able to maintain a *prima facie* case of obviousness as to claim 18. Accordingly, Lee, Moskowitz, and Wolf can not render claim 18 obvious.

C. Rejection of claims under 35 USC §103 in Section 1

In section 3 of the office action, the Examiner rejects claim 7 under 35 USC 103(a) as being unpatentable over Lee (US. Pat. No. 6,590,887) in view of Wolf (US Pat. No. 5,844,922), and further in view of Murray (US Pat. No. 6,539,118).

The applicant respectfully submits that claim 7 is allowable based on its dependency from claim 5, which is now believed to be in form for allowance. Therefore, for reasons similar to those set out in Section A(1) above, the applicant respectfully submits that the Examiner will not be able to maintain a

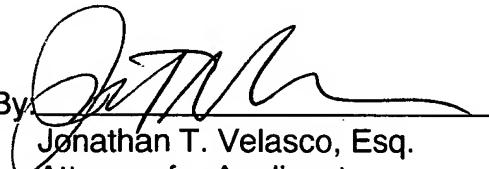
prima facie case of obviousness as to claim 7. Accordingly, Lee, Moskowitz, and Wolf can not render claim 7 obvious.

D. Conclusion

The applicant believes the pending claims are patentably distinguishable from these references. For all the foregoing reasons, an early allowance of claims 1-18 pending in the present application is respectfully requested.

Respectfully submitted,

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